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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,848	10/17/2003	Richard S. Ginn	937.04	2084
8685 7590 08/19/2009 DERGOSITS & NOAH LLP Three Embarcadero Center Suite 410 SAN FRANCISCO, CA 94111				
EXAMINER TYSON, MELANIE RUANO				
ART UNIT 3773		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,848

Applicant(s)

GINN, RICHARD S.

Examiner

MELANIE TYSON

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 7, 9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 6/22/09 and 7/22/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 July 2009 has been entered. Claims 2, 4, 6, 8, 10, and 12 remain cancelled. Claims 5 and 7 remain withdrawn from consideration.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 9, and 11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kensey et al. (U.S. Patent No. 5,676,689). Kensey discloses a locator device (see entire document) comprising an elongate member (28) having a distal [first] opening (304; for example, see Figure 27) in its distal region (28C) and a proximal [second] opening (opening in communication with sideport 28D) in its proximal region which are

connected by a lumen (hollow portion of 28 running through the entire member), wherein the distal region has a substantially uniform diameter, and a bioabsorbable occlusion member (32; for example, see column 13, lines 40-45) in contact with the lumen of the elongate member and located distally of the distal opening of the elongate member (for example, see illustration of similar embodiment shown in Figure 11 just prior to full deployment of the occlusion member), wherein the occlusion member is releasably coupled to the elongate member (for example, see Figure 38 in which the member has been released from the elongate member), and wherein the elongate member is capable of performing the functions as claimed (for example, see column 10, lines 31-39). Kensey discloses the occlusion member is capable of sealing an opening in a blood vessel lumen, thus Kensey's occlusion member is capable of substantially blocking blood flow out of the blood vessel if withdrawn from the vessel and placed on the external side of the opening in the blood vessel if one desired to do so.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Patent No. 5,292,332) in view of Kensey et al. (U.S. Patent No. 5,676,689).

Lee discloses a locator device (see entire document) comprising an elongate member (24) having distal and proximal regions and a lumen extending therebetween (for example, see Figure 3), and a bioabsorbable expandable occlusion member (22; for example, see column 4, lines 18-23 and column 5, lines 61-66) in contact with the lumen of the elongate member (just prior to full deployment of the occlusion member from the elongate member), wherein the occlusion member is releasably coupled to the elongate member (for example, see Figure 6 in which the member has been released from the elongate member), the elongate member is adapted to extend into a blood vessel (for example, see Figure 3), and the occlusion member is capable of substantially blocking blood flow out of the blood vessel when withdrawn from the vessel and placed on the external side of the opening in the blood vessel (for example, see Figure 8). Lee fails to disclose a distal [first] opening in its distal region and a proximal [second] opening in its proximal region to enable blood to flow through the lumen.

Kensey discloses a locator device (see entire document) comprising an elongate member (28). Kensey teaches the elongate member includes a distal [first] opening (304; for example, see Figure 27) in its distal region (28C), a proximal [second] opening

(opening in communication with sideport 28D) in its proximal region, and a sideport (28D) to enable blood to flow through the lumen and be visible outside of the patient's body. It would obvious to one having ordinary skill in art at the time the invention was made to form Lee's elongate member as taught by Kensey. Doing so would provide the user a means for indicating the distal end of the tubular member has entered the interior of the blood vessel, thus effecting the proper positioning of the tubular member within the artery (for example, see column 10, lines 10-39). Lee, as modified by Kensey, yields a locator system in which the occlusion member is in communication with the elongate member and is distal to the distal opening at the instant just prior to full deployment of the occlusion member from the elongate member.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie Tyson/
Examiner, Art Unit 3773
August 14, 2009